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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/287,631	04/07/1999	JOHN M. EBY	03063.0396-0	6525

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EXAMINER

KUHNS, ALLAN R

ART UNIT PAPER NUMBER

1732

DATE MAILED: 11/05/2002

48

Please find below and/or attached an Office communication concerning this application or proceeding.

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# Office Action Summary

Application No.

09/287,631

Applicant(s)

EBY ET AL.

Examiner

KUHNS

Group Art Unit

1732

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE(3) MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- ☒ Responsive to communication(s) filed on AUGUST 7, 2002
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 25-26, 33-46 AND 48-56 is/are pending in the application.
- ☐ Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 25-26, 33-46 AND 48-56 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement

## Application Papers

- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

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## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some\* ☐ None of the:
- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_
- ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s) 47
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other \_\_\_\_\_

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1. Claims 53-56 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The aspect in claim 53 that “.. said second layer is a wear layer having a uniform viscosity that is applied before said chemically embossing, and cured prior to said mechanically embossing” lacks support in the disclosure as filed, and the aspect in claims 54-56 that “.. the mechanically embossed portion of the wear layer includes all of the surface of the wear layer, except the chemically embossed portion” also lacks support in the disclosure as filed.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claim 53 is rejected under 35 U.S.C. 103(a) as being unpatentable over Faust et al.

(3,978,258) as set forth in the rejection of claims 53-54 in the previous Office action.

4. Claims 25-26, 33-46 and 51-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shortway et al. (4,214,028) as set forth in the previous Office action.

5. Claims 48-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shortway et al. as applied to claims 25-26, 33-46 and 51-52 above, and further in view of McCann et al. as set forth in the previous Office action.

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6. Applicants' arguments filed August 7, 2002 have been fully considered but they are not persuasive. Applicants argue that Faust does not teach or suggest a method of making a surface covering comprising chemically embossing a first layer, and mechanically embossing a portion of a second layer, but rather teaches mechanically embossing by selectively crushing the foam layer. The examiner disagrees because the second layer is effectively embossed when the crushing of the foam layer occurs.

Applicants also argue that Faust also does not teach that the second layer is a wear layer having uniform melt viscosity applied before chemically embossing. But it is the examiner's position that the disclosure of Faust et al. would not have led one of ordinary skill in the art to use anything other than a wear layer having a uniform viscosity.

Applicants' arguments concerning claims 54-56 are noted by the examiner, but there is no rejection of these claims based on the Faust reference.

Applicants argue that Shortway proposes performing mechanical embossing on a gelled or pre-cured wear layer and that Shortway clearly does not contemplate mechanically embossing a cured wear layer that is in a softened state. But it is noted by the examiner that the instant specification at page 4, lines 2-3 that "curing" is also known in the art as "fusing". It is also noted by the examiner that Shortway et al. at column 19, lines 12-18 describe mechanical embossing occurring in the range of about 240 °F to about 470 °F, which, it is submitted, is sufficient to cause fusing of the wear layer. Applicants in fact disclose a temperature range for

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curing the wear layer at page 11, line 10 which falls within the above range. Applicants' arguments concerning Shortway et al. are thus not persuasive.

Applicants argue that the reversal of the steps described in Shortway is fundamentally inconsistent with the teachings of Shortway. But McCann et al. disclose to one of ordinary skill in the art that desired surface shapes may be obtained through reversal of the steps.

In addition, Applicants argue that McCann, at column 4, lines 8-15 describes chemical etching and mechanical embossing in the alternative. But McCann et al. describe the use of a pattern of chemical inhibitors which result in a textured surface at column 4, lines 1-12 so one of ordinary skill in the art would have expected chemical embossing or etching to have occurred when the option of mechanical embossing is also undertaken.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Allan Kuhns whose telephone number is (703) 308-3462. The examiner can normally be reached on Monday to Thursday from 7:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jan Silbaugh, can be reached on (703) 308-3829. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-7718.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

*Allan R. Kuhns*  
**ALLAN R. KUHN**  
**PRIMARY EXAMINER** AU 1732  
11-3-02